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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224272
Party	Defendant Pac-West Distributing NV LLC
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AFAB INDUSTRIAL SERVICES, INC.,)	
)	
)	Opposition No. 91224272
)	
Opposer,)	Serial No. 86/599421
)	Mark: SUPER RUSH
vs.)	
)	
PAC-WEST DISTRIBUTING NV LLC)	
)	
)	
Applicant.)	
)	
)	

APPLICANT’S MOTION FOR SUMMARY JUDGMENT

I. INTRODUCTION

Applicant, Pac-West Distributing NV LLC (“PWD” or “Applicant”) respectfully moves pursuant to Fed. R. Civ. P. 56 and Rule 2.127(b) of the Trademark Rules of Practice for summary judgment in favor of Applicant on all claims set out in the Notice of Opposition (“Opposition”) filed by Opposer AFAB industrial Services, Inc. (“AFAB” or “Opposer”).

AFAB opposes the mark SUPER RUSH, Serial No. 86/599421 for the goods, “All-purpose cleaners; Cleaning preparations” in International Class 003 (“PWD Mark”). As grounds for the opposition, AFAB alleges that PWD’s use of the PWD Mark does not constitute lawful use of a trademark in commerce. AFAB argues that PWD’s use of the PWD Mark on all purpose cleaners and cleaning preparations is unlawful pursuant to 15 U.S.C. §§ 2057a and 2057b and therefore PWD has not made any lawful use of the PWD Mark in commerce (Count I) and its statement that it had made lawful use to the trademark office was fraudulent (Count II).

This matter is ripe for resolution on summary judgment because (i) PWD has submitted its initial disclosures to AFAB; and (ii) the sale of all-purpose cleaners and cleaning preparations, regardless of whether they contain isobutyl nitrites and/or alkyl nitrites, is not a *per se* violation of 15 U.S.C. §§ 2057a and 2057b.

Preliminarily, it should be noted that AFAB's Opposition is wrought with inaccuracies, including several false statements which appear to have been knowingly made in an attempt to intentionally mislead the TTAB. In particular, the Opposition contains photographs of certain product packaging in the Opposition AFAB knows are not PWD products, but rather unlicensed, infringing products.

Regardless, such inaccuracies are not material for purposes of this Motion for Summary Judgment as it is not necessary for TTAB to go beyond a review of PWD's application, the Opposition itself, and the language of 15 U.S.C. §§ 2057a and 2057b to determine this motion.

II. UNDISPUTED FACTS

This motion for summary judgment is based on the following undisputed facts:

1. PWD filed an application for SUPER RUSH for the following goods, "All-purpose cleaners; Cleaning preparations" in international Class 003.
2. Such goods are not a *per se* violation of 15 U.S.C. §§ 2057a and 2057b regardless of whether the products contain isobutyl nitrites and/or alkyl nitrites.

III. ARGUMENT

A. The Summary Judgment Standard

Summary judgment is appropriate where "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56; *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S.

574, 585-87 (1996).

The opposing party's mere allegation of factual issues will not defeat a properly supported motion for summary judgment. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986); *BellSouth Telecomms., Inc. v. W.R. Grace & Co.*, 77 F.3d 603, 615 (2d Cir. 1996). Rather, to create a material issue for trial, there must be sufficient evidence in the record to support a verdict in the non-moving party's favor. *Tullo v. City of Mt. Vernon*, 237 F. Supp. 2d 493 (S.D.N.Y. 2002).

The purpose of summary judgment is to avoid unnecessary trials and to save the time and expense of litigation where there is no genuine issue of material fact that exists and where no evidence beyond the evidence submitted with respect to the summary judgment motion could reasonably change the outcome. *Pure Gold v. Syntax (U.S.A.) Inc.*, 739 F.2d 624, 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984); *Nature's Way Prods., Inc. v. Nature's Herbs, Inc.*, 9 U.S.P.Q.2d 2077, 2080 (T.T.A.B. 1989).

Here, there is no evidence to support Opposer's contention that cleaning products which contain isobutyl nitrites and/or alkyl nitrites are *per se* unlawful under federal law. Opposer cannot sustain its burden of showing any genuine factual issue, and summary judgment should be granted in favor of Applicant with respect to all claims raised in the Opposition. *See Celotex Corp. v. Cartrett*, 477 U.S. 317, 325 (1986) (holding that the movant may carry its burden by demonstrating the absence of evidence to support the non-movant's claims).

B. Applicant's Goods in the Opposed Application Are Lawful

In the Opposition AFAB has alleged that PWD's use of the PWD Mark on all purpose cleaners and cleaning preparations purportedly containing isobutyl nitrites and/or alkyl nitrites is unlawful pursuant to 15 U.S.C. §§ 2057a and 2057b. Those statutes state in full,

15 U.S.C. §§ 2057a

(a) In general

Except as provided in subsection (b) of this section, butyl nitrite shall be considered a banned hazardous product under section 2057 of this title.

(b) Lawful purposes

For the purposes of section 2057 of this title, it shall not be unlawful for any person to manufacture for sale, offer for sale, distribute in commerce, or import into the United States butyl nitrite for any commercial purpose or any other purpose approved under the Federal Food, Drug, and Cosmetic Act [21 U.S.C. 301 et seq.].

(c) Definitions. For purposes of this section:

- (1) The term “butyl nitrite” includes n-butyl nitrite, isobutyl nitrite, secondary butyl nitrite, tertiary butyl nitrite, and mixtures containing these chemicals.
- (2) The term “commercial purpose” means any commercial purpose other than for the production of consumer products containing butyl nitrite that may be used for inhaling or otherwise introducing butyl nitrite into the human body for euphoric or physical effects.

(d) Effective date

This section shall take effect 90 days after November 18, 1988.

15 U.S.C. §§ 2057b

(a) In general

Except as provided in subsection (b) of this section, volatile alkyl nitrite shall be considered a banned hazardous product under section 2057 of this title.

(b) Lawful purposes

For the purposes of section 2057 of this title, it shall not be unlawful for any person to manufacture for sale, offer for sale, distribute in commerce, or import into the United States volatile alkyl nitrites for any commercial purpose or any other purpose approved under the Federal Food, Drug, and Cosmetic Act [21 U.S.C. 301 et seq.].

(c) “Commercial purpose” defined

For purposes of this section, the term “commercial purpose” means any commercial purpose other than for the production of consumer products containing volatile alkyl nitrites that may be used for inhaling or otherwise introducing volatile alkyl nitrites into the human body for euphoric or physical effects.

(d) Effective date

This section shall take effect 90 days after November 29, 1990.

15 U.S.C. §§ 2057a and 2057b (emphasis added).

It is undisputed that PWD is seeking registration the PWD Mark for the goods, “all-purpose cleaners; cleaning preparations” and for no other goods. These products are in no way a *per se* violation of 15 U.S.C. §§ 2057a and 2057b which solely bans products “that may be used for inhaling or otherwise introducing [butyl nitrite / volatile alkyl nitrites] into the human body for euphoric or physical effects.”

In order to meet its burden of proof that a use is unlawful, the party asserting unlawfulness must establish that:

the issue of compliance has previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been *per se* violation of a statute regulating the sale of a party’s goods

General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, at 1273-1274 (TTAB 1992). Here there is no allegation that compliance has been previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved. Thus AFAB must demonstrate a *per se* violation of a statute regulating the goods set out in PWD’s trademark application.

The reason a *per se* violation is required was expressed in the case *Satinine Societa in Nome Collettivo di S.A. e M. Usellini v. P.A.B. Produits et Appareils de Beaute*, where the TTAB recognized,

due to a proliferation of federal regulatory acts in recent years, there is now an almost endless number of such acts which the Board might in the future be compelled to interpret in order to determine whether a particular use in commerce is lawful. Inasmuch as we have little or no familiarity with most of these acts, there is a serious question as to the advisability of our attempting to adjudicate whether a party’s use in commerce is in compliance with the particular regulatory act or acts

which may be applicable thereto.

209 USPQ 958, 964 (TTAB 1981).

Here, PWD has filed the PWD Mark for “all-purpose cleaners; cleaning preparations.” These products are not a *per se* violation of the identified statutes and the Board should rule in favor of Applicant on both counts in the Opposition.

IV. CONCLUSION

For the foregoing reasons, Applicant has established that there are no genuine issues of material fact preventing the entering of summary judgment in favor of Applicant. Consequently, Applicant respectfully requests that the Board grant its motion for summary judgment in its favor on the claims in the Opposition.

Respectfully submitted,

Dated: December 30, 2015

By: 

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S MOTION FOR SUMMARY JUDGMENT** has been served on the attorney of record for Opposer on December 30, 2015 by U.S. First Class Mail, postage prepaid, with a courtesy copy provided by email to:

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